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Gudrun E. Hockett, Patent Agent

Applicant: Marius Cornea et al.
Serial No: 10/709,375
Filed: 4/30/2004
Title: Bushing for a Hydraulic Valve
Examiner: Vishal A. Patel
Art Unit: 3673

Commissioner for Patents
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Contrary to the statement in the office action summary, claims 1 and 4-15 are in the application; claims 2 and 3 have been canceled with the amendment dated 6/30/05. No claim 16 has ever been presented.

In response to the office action dated 11/1/2005, Applicant herewith elects the **species II - Figs. 5-8** for further prosecution **with traverse**. Claims 1 and 4-14 read on the elected species and are elected with traverse.

Applicant herewith request reconsideration of the restriction/election requirement for the following reasons.

37 CFR 1.146 Election of Species reads: "In the first action on an application..." This application has already received a first action on the merits; this first action did not include a requirement to elect. Therefore **37 CFR 1.146 Election of Species** no longer applies since a first action has already issued in this application.

37 FR 1.141(a). 37 CFR 1.141(a) states that "...more than one species of an

invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application ..". The present invention only has **two** species which clearly does not exceed a reasonable number of species as the number two is the next up from the number one.

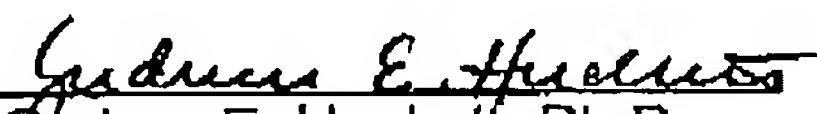
37 CFR 1.142(a), second sentence, states that a "requirement will normally be made before any action on the merits". **MPEP 811 Time for Making Requirement** states that "Before making a restriction requirement **after the first action on the merits**, the examiner will consider whether there will be a serious burden if restriction is not required."

Moreover, **MPEP 803 Restriction - When Proper** states that "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions."

There is certainly no serious burden on the examiner to review two species presented in 13 claims after a first office action on the merits has already issued. Examiner has not provided any reason supporting a serious burden by identifying separate classifications or a separate status in the art or a different field of search for the two species presented. Therefore, the restriction requirement appears to be a clear violation of the patent rules and the examination guidelines. Reconsideration is requested.

Should the Examiner have any further objections or suggestions, the undersigned would appreciate a phone call or **e-mail communication** from the examiner to discuss appropriate amendments to place the application into condition for allowance.

Respectfully submitted on November 29, 2005,


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11/29/05: Response Restriction/Election Req. Ser. No. 10/709,375 - Inventor(s): Comea et al. - Filed: 4/30/2004